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SUPREME COURT
OF THE
UNITED STATES

OCTOBER TERM, 1925

NUMBER 107

THE ALEXANDER MILBURN COMPANY,
Petitioner

vs.

DAVIS-BOURNONVILLE COMPANY,
Respondent

BRIEF FOR PETITIONER

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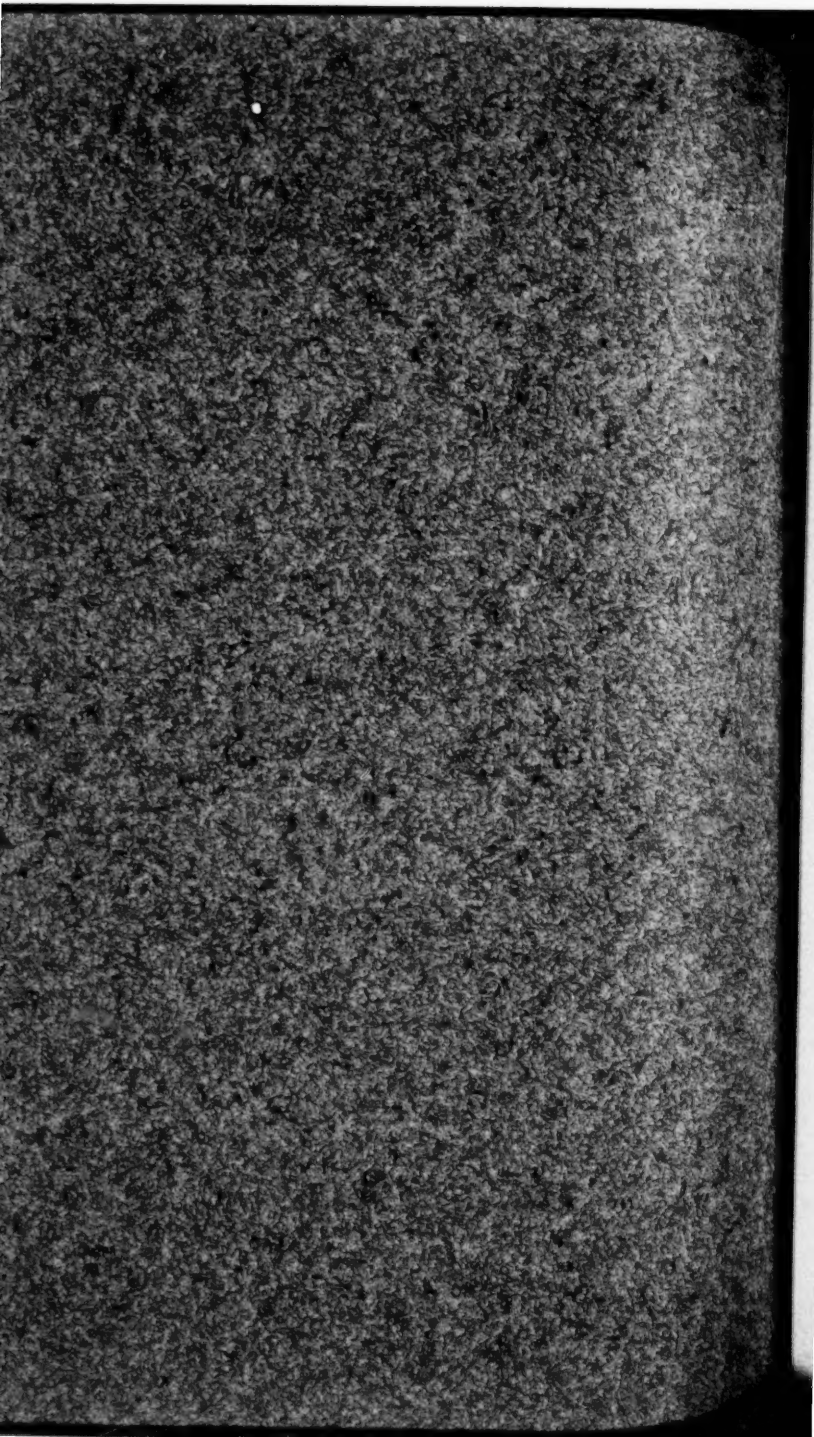

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Supreme Court of the United States

OCTOBER TERM—1925.

THE ALEXANDER MILBURN COMPANY, *Petitioner,*
vs.
DAVIS-BOURNONVILLE COMPANY, *Respondent.*
} No. 107.

BRIEF FOR PETITIONER.

TO THE HONORABLE THE SUPREME COURT OF THE UNITED STATES:

This case comes before the Court on certiorari to the United States Circuit Court of Appeals for the Second Circuit. The opinion of the Court below is reported in Vol. 1 (2d) Fed. Rep. 227 (R., p. 102).

Statement of Facts.

This suit was brought by Davis-Bournonville Company, respondents, against the Alexander Milburn Company, petitioner, in the United States District Court for the Southern District of New York by Bill of Complaint filed on or about January 31, 1919, alleging infringement of three Letters Patent as follows:

874,666, Gauthier et al., Dec. 24, 1907;
880,099, Rodriques-Ely et al., Feb. 25, 1908;
1,028,410, Whitford, June 4, 1912.

Said Court in a decree entered on or about February 9, 1924, held Letters Patent 874,666 and 1,028,410 valid and infringed and patent 880,099 invalid (Record, p. 97).

Both parties appealed from said decree to the United States Circuit Court of Appeals for the Second Circuit, and said Circuit Court of Appeals on or about May 26, 1924, filed its opinion (Record, p. 102) affirming the decree of the said District Court.

The petition related to a question of law in respect to patent to Whitford 1,028,410 only, the other two patents not being involved. Claims 3, 6 and 7 of the Whitford patent were in suit.

Ground of Petition.

The writ of certiorari was prayed for on the ground that the decision of the Circuit Court of Appeals below is in conflict with the decisions of the Circuit Court of Appeals, Sixth Circuit, and the Court of Appeals of the District of Columbia, upon a question of law, the settlement of which is of great importance to the public.

How the Question of Law Arose.

The question of law arose in the present case as follows:

1. Plaintiff (Respondent) sued on claims 3, 6 and 7 of the Whitford patent 1,028,410.

2. Defendant pleaded (Record, p. 15) that the patentee, Whitford, was not the original and first inventor or discoverer of any material or substantial part of the thing patented by said Letters Patent No. 1,028,410, but unjustly obtained said Letters Patent for that which was in fact earlier invented or disclosed by others, citing Harlan A. Clifford, of Jersey City, New Jersey, the patentee of Letters Patent 1,016,613, February 6, 1912, and others. This defense was pleaded under Section 4920 R. S., which provides that the defendant may plead and prove on trial:

> "Fourth. That he (the patentee) was not the original and first inventor or discoverer of any material and substantial part of the thing patented;"

3. Defendant introduced a certified copy of the file wrapper of patent No. 1,016,613 to Harlan A. Clifford, granted February 6, 1912, in support of this defense (Record, p. 57).

4. Clifford filed his application Serial No. 605,741 January 31, 1911, and his patent issued February 6, 1912 (Record, pp. 86-87).

5. Whitford filed his original application March 4, 1911, and his divisional application upon which the patent in suit issued January 31, 1912, and his patent issued June 4, 1912 (Record, pp. 56-57).

6. It is conceded that Clifford disclosed in his application of January 31, 1911, but did not claim, the invention covered by the Whitford claims, and that

Whitford's application of March 4, 1911, is the earliest record of his invention.

On the question of identity the Court below said:

> "Clifford sought and obtained protection for an invention quite distinct from that of Whitford, and his claims do not touch or affect those of Whitford; but in the disclosure of his specification he shows a structure which plaintiff admits,—'does [redacted] comply with the requirements of the Whitford patent' " (Record, p. 104).

The Invention in Issue.

The legal question involved may be fully discussed without reference to the physical structures in controversy and it seems only necessary to say a word in respect to the latter.

Whitford's device is entitled a "Blow Pipe" and Clifford's is called a "Torch." Each is what is commonly called an "Oxy-acetylene Torch," a device in common use in one form or another for many years for either cutting or welding metals. Every feature of the Whitford device involved in controversy has its physical and functional counterpart in the Clifford device, in substantially the same arrangement, and the features involved are as essential to the proper operation of the Clifford torch as they are to that of Whitford.

The Question of Law Involved.

The question presented is stated by the Court below in varying language in the following paragraphs:

"That question is this,—assume two copending applications for patent, both ultimately granted; each discloses certain substantially identical matter, which matter is not made the basis of claims in, and is not covered by the claims of the application first filed, but is the basis of and is covered by the claims of the later application;—under such circumstances can the patent of the earlier filing-date be used to invalidate the other patent? (Record, p. 105).

* * * * * * *

"Thus the question is narrowed to this: Does the phrase 'first inventor' of the fourth defense, signify one who describes patentable matter or one who both describes and claims it? (Record, p. 197).

* * * * * * *

"The question may be thus put,—is mere disclosure (confidentially made to the Commissioner of Patents) and no more, per se sufficient evidence of invention? We think that it is not, for the reason that in the absence of an appropriate claim there is no evidence of the perfection of the mental concept which constitutes the intellectual part of invention (Record, p. 107).

Applied to the present case the question of law presented is: Was Whitford the original and first inventor or discoverer of the thing patented to him notwithstanding the earlier disclosure (without claiming) of the same thing in the application which resulted in the Clifford patent, which patent issued while the later application of Whitford was still pending?

Opinion of the Court Below.

The Court says, in part:

> "If Clifford had not only described but claimed the matter now sought to be used by defendant, the Sundh case, *supra* (p. 67) is clear in holding that in the absence of other evidence, and because an application is a constructive reduction to practice, Clifford would have been the original and first inventor or discoverer because he filed the first application; and the fourth defense would succeed" (R., p. 106).
>
> * * * * * * *
>
> "Can it now be said that, by the mere statement of matter which he did not think to use, Clifford had rounded out and completed the mental portion of his inventive act?
>
> We think it cannot. Clifford may be said to have observed certain phenomena, but he certainly drew from them no conclusion that such phenomena contained patentable matter.
>
> The question may be thus put,—is mere disclosure (confidentially made to the Commissioner of Patents) and no more, per se sufficient evidence of invention? We think that it is not, for the reason that in the absence of an appropriate claim there is no evidence of the perfection of the mental concept which constitutes the intellectual part of invention" (R., p. 107).
>
> * * * * * * *
>
> "For the reasons now set forth we hold that a 'first inventor' within the meaning of that phrase as used in the fourth defense of 4920 must be a person who perfects his invention;

> no invention can be intellectually perfected unless it is thought out and concluded, and the only evidence of such perfected invention ordinarily derivable from any patent is a union of disclosure and claim. Evidence of disclosure only (all we have here) is not enough; and before publication disclosure alone does not evidence anticipation" (R., p. 108).

Undoubtedly Judge Hough had no thought of minifying the Clifford specification as a disclosure in fact nor of holding that a claim materially aids the disclosure of a specification, for he said in Westinghouse E. & Mfg. Co. vs. Metropolitan E. Mfg. Co., 290 Fed. Rep. 661, 664:

> "What any patentee has invented is theoretically what he discloses, and the disclosure is the specification. A claim is a definition of that which has been described in the specification. A disclosure tells how to do that of which the claim attempts definition. Theoretically, the celebrated "man skilled in the art" knows how to do what the inventor did when he has perused the disclosure. Whether one infringes a patent primarily depends, to be sure, upon consideration of the claims; but no man would know how to practice the invention by reading the claims, any more than a student would learn the proper demonstration of a theorem by reading the theorem itself."
>
> * * * * * * *
>
> "A claim is not a disclosure; but every claim must be justified by the disclosure."

Error of the Court Below.

We are constrained to believe that the Court below erred

1. In assuming that under the fourth defense of R. S. 4920 it was necessary to show that Clifford was the "first inventor," whereas the statute simply requires proof that Whitford "was not the original and first inventor." No *inter partes* question of priority of invention is involved in this defense.

2. In overlooking the presumption of law that what Clifford disclosed and did not claim was old and known when he filed his application.

In a similar case the Court of Appeals, D. C., said:

> "It is of no consequence that Lane does not include this device among the claims of his own invention. His failure so to do simply implies either that he abandoned it to the public, or that he regarded it as already well known to the art. It does not help the appellants in any manner that he does not claim it." Millett and Reed vs. Duell, Commissioner of Patents, 18 App. D. C. 186; 96 O. G. 1241.

In Mahn vs. Harwood 112 U. S. 354, 361, this Court said:

> "The presumption is, and such is generally the fact, that what is not claimed was not invented by the patentee, but was known and used before he made his invention. But, whether so or not, his own act has made it public property if it was not before. The patent itself, as soon as it is issued, is the

evidence of this. The public has the undoubted right to use, and it is to be presumed does use, what is not specifically claimed in the patent. Every day that passes after the issue of the patent adds to the strength of this right."

3. In overlooking the inequity of the grant to Whitford of a monopoly which would deprive Clifford of the right to use important features of his own device and deprive the public of the right to use what was disclosed in Clifford's prior application and which was either known to Clifford to be old, or, if invented by Clifford, deliberately dedicated to the public.

Abandonment Accrues to the Public.

There are many cases in which this Court and the lower Courts have held that the first inventor, having reduced his invention to practice, may abandon or dedicate his invention to the public, by failure to claim, or for other reasons, but we have found no case in which such abandonment or dedication has been held to entitle a later inventor to a patent for the invention.

Keystone Bridge Co. vs. Phoenix Iron Co., 95 U. S. 274, 279.

Miller vs. Brass Co., 104 U. S. 350, 352.

Eames vs. Andrews, 122 U. S. 40, 59, 60.

Deering vs. Winona Harvester Works, 155 U. S. 286, 296.

McClain vs. Ortmayer, 141 U. S. 419, 423, 424.

In the last mentioned case it is said:

> "Nothing is better settled in the law of patents than that the patentee may claim the whole or only a part of his invention, and that if he only describe and claim a part, he is presumed to have abandoned the residue to the public."

Assuming that Clifford was the inventor of the thing he failed to claim, he made it public property as soon as the patent issued and every day that passed thereafter added to the strength of the public right. Mahn vs. Harwood, 112 U. S. 354, 361.

The right of the public to use the invention was tentative during the period of two years from the date of the Clifford patent as during this period Clifford might have filed an application for a reissue, or a divisional application, claiming the invention. Chapman et al. vs. Wintroath, 252 U. S. 126, 137.

If at any time within two years from the date of his patent Clifford had filed a reissue or divisional application embodying the Whitford claims in issue, he would have been entitled to a patent with those claims, despite Whitford, as his application would have related back to his original filing date. Chapman vs. Wintroath, *supra;* Smith & Griggs Mfg. Co. vs. Sprague, 123 U. S. 249, 250; Millett & Reed vs. Duell, Commissioner of Patents, 18 App. D. C. 186; 96 O. G. 1241; ex parte Grosselin, 97 O. G. 2977.

The issuance of such a patent to Clifford, after interference with Whitford, would have invalidated the Whitford claims as, obviously, there cannot be two monopolies of the same thing. The Whitford

patent was allowed through oversight of the Patent Office and contrary to established practice as pointed out hereinafter in discussing Patent Office Rules (Post, p. 19).

Clifford perfected his invention when he filed his application. The application was a constructive reduction to practice—of what it disclosed—before Whitford conceived. Chapman vs. Wintroath, 252 U. S. 126-137; Smith and Griggs Mfg. Co. vs. Sprague, 123 U. S. 249, 250, 8 Sup. Ct. 122; Von Recklinghausen vs. Dempster, 34 App. D. C. 474, 476, 477.

Between the time that Clifford filed his application and the time, two years from his patent date, when the public came into full possession of what he dedicated, there was no lapse, no period within which a later inventor might have acquired a right. Clifford had an inchoate right to claim the invention or to re-claim it up to the instant the public came into full possession.

Cases in Conflict with the Opinion of the Court Below.

In Roberts vs. Ryer, 91 U. S. 150, a patent to Sanford was sued on. Sanford could not carry his date of invention back of the summer of 1855 when his application was filed (p. 155). In defense it was alleged that a patent to Lyman granted later but applied for earlier was an anticipation. Lyman filed his original application Sept. 21, 1854 (p. 158). He withdrew his application April 19, 1855, and renewed it Nov. 28, 1855, in the meantime, keeping in

correspondence with the Department and pushing his claim. A patent was granted to him March 25, 1856. Sanford then surrendered his patent and obtained a reissue. "The principal defense relied upon was the prior invention of Lyman" (p. 151). After reciting the facts this Court, by Mr. Chief Justice Waite, said:

> "We base our decision upon the facts shown to us. We think the evidence establishes, beyond all question, that Lyman, and not Sanford, was the original and first inventor of all there is of this improvement" (p. 159).

In Pope Manufacturing Co. vs. Gommully Manufacturing Co., 144 U. S. 224, a patent to Peters was sued on and this Court said:

> "There was also a patent issued to one Smith upon the same day the Peters patent was issued, namely, Nov. 20, 1877, but upon an application filed Sept. 1, 1877, prior to Peters' application and, therefore, anticipating Peters' patent" (p. 244).

In the opinion of the trial Court in the instant case Judge Hand said:

> "In the Sixth Circuit it has been established by an unusual number of cases that copending applications count precisely as though they were part of the prior art. The comparison on the issue of prior invention is of the disclosures. This has been the rule for over thirty years as established by the fol-

lowing cases: Cochren vs. Zimmerman, 53 Fed. Rep. 801; Drewson vs. Hartje Paper Mfg. Co., 131 Fed. Rep. 734; Electric, etc. Co. vs. Westinghouse, etc., Co., 171 Fed. Rep. 83; Lemley vs. Dobson-Evans Co., 243 Fed. Rep. 391; Jackson Co. vs. Adler, 243 Fed. Rep. 386; Twentieth Century Co. vs. Loew Co., 243 Fed. Rep. 373; Diamond Power Specialty Co. vs. Mertz Capsule Co., 276 Fed. Rep. 274; Concrete Appliances Co. vs. Meinken, 262 Fed. Rep. 958; Gen. Electric Co. vs. Cooper Hewitt Co., 249 Fed. Rep. 61."

It is noted that the opinion in Cochren vs. Zimmerman, the earliest case noted above, was written by Mr. Chief Justice Taft, then Circuit Judge.

In the latest case in the Sixth Circuit, Naceskid Service Chain Co. vs. Perdue et al., 1 Fed. Rep., 2d, 924, 925, it is said by Judge Denison:

> "Under the settled rule in this circuit (Lemley vs. Dobson (C. C. A. 6), 243 F. 391, 156 C. C. A. 171), the filing date of the Young application, shown by the Young patent, if uncontradicted, is sufficient evidence that Young was the inventor of the device on that date, and hence that Nace, who does not claim conception until a later date, was not the first inventor."

In the First Circuit the question here under consideration is discussed elaborately by Judge Colt in Automatic Weighing Machine Co. vs. Pneumatic Scale Corporation, 166 F. R. 288, and numerous authorities cited. Among other things, it is said:

> "The further argument is advanced that an application is only evidence of a disclo-

sure of a somewhat stronger character than a conception proved by drawings and disclosure. The answer to this argument is that the courts have uniformly held that an application which eventuates in a patent, and which sufficiently describes the invention, is conclusive evidence that the invention was made at the time the application was filed.

While the defendant insists that the filing of an allowable application is not the equivalent of reduction to practice, it admits that the issue of a patent is the 'equivalent in effect in the art to reduction to practice by the completion of a machine.' We cannot see the force or reasonableness of this position. The issuance of the patent is an act of government, with which the inventor has nothing to do except to pay the final fee, while in the filing of a complete and allowable application the inventor has performed all the acts required of him under the statute for the grant of a valid patent." (p. 297).

In the Third Circuit the law is found in the following cases:

In Diamond Drill Machine Co. vs. Kelly Brothers, 120 Fed. 295, a case in the Circuit Court, E. D. Penna., Judge Archbald said (page 298):

"On the other hand, there can be no question as to the existence of the Henry M. Jackson machine as early as July 16, 1896, when he applied for his first patent, for the diagrams which accompanied the application show it exactly as it now is except that the jaws are V-shaped, instead of being serrated. *No claim was made for the separate opera-*

tion of the rolls and jaws, but that is not material. It was a feature of the machine, and that is enough for our present purposes." (Italics ours.)

In Westinghouse vs. Chartiers Val. Gas Company, 43 F. R., 582, 588 (Circuit Court W. D. Penna.), Judge Acheson said:

> "But it by no means follows that Nicholson's application is not to be received for any purpose. It has neither been withdrawn nor rejected. Abandonment by him cannot be alleged. In the interference proceeding he was awarded priority of invention over Verner. That he was prior to Verner is indisputable under the proofs before the Court. The utility of the device in question is demonstrated. It would then be most extraordinary if Nicholson's application could not be shown as affecting Verner's title to the monopoly here set up against the defendant and the public. I think the cases of Northwestern Fire Ex. Co. vs. Philadelphia Fire Ex. Co., supra, and the Corn Planter Patent, supra, are direct authorities to show that the Nicholson application is competent evidence as bearing on the thing alleged to be within the first and second claims of his patent. And I have only to add that, in my opinion, Nicholson's application clearly *described the identical and mechanical construction or combination here claimed to be covered by the Verner patent.*" (Italics ours.)

It will be noted that nothing is said in the above as to the claims of the prior application.

In the Seventh Circuit, in Barnes Automatic Sprinkler Co. vs. Walworth Mfg. Co. et al., 51 F. R. 88 (Circuit Court), a patent to Barnes granted Oct. 19, 1880, upon application filed June 21, 1880, was sued on and a patent to Talcott issued January 31, 1882, upon an application filed April 8, 1879, was cited as an anticipation. The Court said:

> "I am therefore very clear that the Talcott patent of January 31, 1882, which relates back to the time it was applied for in April, 1879, clearly anticipates the 4th and 5th claims of the complainant's patent."

On appeal the opinion of the lower court was affirmed by the Circuit Court of Appeals. Barnes Automatic Sprinkler Co. vs. Walworth Mfg. Co. et al., 60 F. R. 605. It appears from the opinion of Judge Woods, on appeal, that the defendant pleaded that "the grantee of the patent in suit was not, and that the patentee of a patent of later date, issued upon an earlier application, was the first inventor." The Court discusses Bates vs. Coe, 98 U. S. 31, and distinguishes the Barnes case from the rule in that case.

In Farmers' Handy Wagon Co. vs. Beaver Silo & Box Mfg. Co., C. C. A. 7, 236, F. R. 731, Judge Kohlsaat, in discussing the bearing of prior applications upon the McClure patent, in suit, said:

> "They are thus in the prior art as to McClure for whatever they disclose. This should, we hold, be limited to such matters as are included in their several claims, unaided

> by their specifications or by extrinsic evidence except where necessary to elucidate and make the same clear."

In the same paragraph Judge Kohlsaat cites as authority Barnes Sprinkler Co. vs. Walworth, above referred to, which does not support the proposition that in considering a prior application under the fourth defense, the claims are controlling.

In further discussing the prior co-pending applications of Haag and Crosby, the Court said:

> "While both Haag's and Crosby's inventions are prior to McClure's, it is evident that, to overcome the presumptions above set out, the Court must be able to find very clearly from the evidence that the *subject matter* of Crosby is practically identical with that of McClure's claims." (p. 737. Italics ours.)

The Court then proceeds to compare the actual structure of Crosby's application with the structure of the McClure patent, without reference to claims and finds "we are satisfied that nothing in the prior art as shown, or prior knowledge, would justify us in holding that the patent in suit is void for want of patentable novelty." We are left in doubt as to the exact attitude of the Court on the importance of the claims in the prior copending application set up under the fourth defense.

Other cases in the Seventh Circuit leave us in doubt as to the law in that Circuit on the question at bar.

Hamilton Beach Mfg. Co. vs. P. A. Geirer Co., 230 F. R. 430, 435.

Camp Bros. & Co. vs. Portable Wagon Dump & E. Co., 251 F. R. 603.

In the Ninth Circuit in Willard vs. Union Tool Co., 253 F. R. 48, 52 (C. C. A.) it is said:

> "When two patents for the same invention have been issued to independent inventors, the rule is that the dates of their inventions are: (1) The date of the patents; (2) the dates of the applications, provided the application sufficiently describes the invention; and (3) the dates of actual reduction to practice. In the absence of other proof, the filing of the application is taken to be a constructive reduction to practice. In Kearney vs. Lehigh Valley R. Co. (C. C.) 32 Fed. 321, 322, Mr. Justice Bradley said:
>
> "The date of the application, if it describes the invention sufficiently, is conclusive evidence that the invention was made prior to such date."

In the Court of Appeals of the District of Columbia, the question as to whether a patent, disclosing without claiming an invention, when cited as an auticipation, speaks from its application date or from its patent date has been uniformly decided contrary to the holding of the Court below in the present case. The decisions of the Court of Appeals D. C., are of great importance as they control the interpretation of the law in the Patent Office.

In Millett and Reed vs. Duell, Commissioner of Patents, 18 App. D. C. 186; 96 O. G. 1241 it is said:

> "It is of no consequence that Lane does not include this device among the claims of his own invention. His failure so to do simply implies either that he abandoned it to the public, or that he regarded it as already well known to the art. It does not help the appellants in any manner that he does not claim it."
>
> * * * * * * *
>
> "But the fact which shows such anticipation is the state of the art at the time as evidenced by the drawings and specifications of Lane's application. For it is the condition of the art at the time at which an alleged invention is made, and not the existence of a patent, which in this connection is no more than evidence of the state of the art, which determines whether an invention claimed is actually an invention or not under the patent law. And this state of the art may be shown by a printed book, a periodical publication, a newspaper, anything in fact which can be regarded in law as reasonably sufficient proof of the fact. This we understand to be the rule deduced from reason and the authorities.

The Doctrine Announced by the Court Below is in Conflict With the Uniform Practice in The Patent Office During, At Least, the Last Fifty Years.

In United States vs. Hill, 120 U. S. 169, 182, this Court said:

"In Edwards' Lessee vs. Darby, 12 Wheat. 206, 210, it was said: 'In the construction of a doubtful and ambiguous law, the contemporaneous construction of those who were called upon to act under the law, and were appointed to carry its provisions into effect, is entitled to very great respect.' To the same effect are United States vs. Dickson, 15 Pet. 141, 145; United States vs. Gilmore, 8 Wall. 330; Smythe vs. Fiske, 23 Wall. 374, 382; United States vs. Moore, 95 U. S. 760, 763; United States vs. Pugh, 99 U. S. 265, 269; Hahn vs. United States, 107 U. S. 402, 406; and Five per cent. Cases, 110 U. S. 471, 485. In the case of Brown vs. United States 113 U. S. 568, the same doctrine was applied, the cases in this court on the subject being collected, and it being said that a 'contemporaneous and uniform interpretation' by executive officers charged with the duty of acting under a statute 'is entitled to weight' in its construction, 'and in a case of doubt ought to turn the scale.' A still more recent case on the subject is United States vs. Philbrick, ante, 52, where this language is used: 'A contemporaneous construction by the officers upon whom was imposed the duty of executing those statutes is entitled to great weight; and since it is not clear that that construction was erroneous, it ought not now to be overturned."

See also Baltzell vs. Mitchell C. C. A. First, 3 Fed. Rep. 2nd, 428, 430 and authorities there cited.

Prior to 1880 it was the custom of the Patent Office to declare an interference between an application claiming an invention and a patent disclosing but not claiming the invention. Presumably this was for the double purpose of ascertaining whether

the applicant was the first inventor and of giving the patentee an opportunity to prevent the applicant from unjustly obtaining a patent which would prevent him from using what he had disclosed but not claimed in his patent.

In ex parte E. S. Wright, 1870 C. D. 60, Commissioner Fisher said:

> "It is true that, in the argument before the Office and the judge, it was urged that the interference was improperly declared, because Wright made no claim to the device in his patent. Mr. Justice Fisher seems to have thought that there was force in this point, although he expressly declines to base his decision upon it. In truth, the objection is without force. A subsequent application which claims a device which is shown in a prior patent interferes with that patent whether the device be or be not claimed in the patent. In the first place, if the applicant succeeds, it follows, that the patentee can no longer use the whole of that which he has described in his patent; and in the second, if the applicant makes claim to a device which is shown in an earlier patent the Office can grant no patent to him; for, prima facie, he is not the first but the second inventor. He must prove priority, and the necessity for proof creates the necessity for the interference."

The practice is further stated by Commissioner Paine in Bell vs. Gray et al, 15 O. G. 776-777, after quoting the statute (R. S. 4904) as follows:

> "An interference will arise under this statute, as construed by the rules and practice

> of the Patent Office, whenever a like patentable invention is shown in one application and claimed in another. Between an application and an unexpired patent an interference arises only when an invention is shown in both and claimed in the application. These principles will be applied to the case now under consideration."

In ex parte Bland, 16 O. G. 47 (April 8, 1879), Commissioner Paine refused to allow an application of Bland in view of a patent granted to Carpenter showing but not claiming the invention claimed by Bland, without interference. In the syllabus it is stated:

> "The present practice of the Patent Office permits an application to be placed in interference with an unexpired patent which shows, but does not claim the subject matter claimed in the application."

The reason, or at least one reason, for the practice referred to is stated in the decision (page 48) as follows:

> "The law gives the inventor a patent for what he invents and claims, and also a right to a reissue patent for what he invents and shows, but, through inadvertence, fails properly to claim. To ignore the obligation which the original patent imports of a right to a reissue for what the patentee shows, but, through inadvertence, does not claim, at the ex parte request of an applicant, basing his claim to priority of invention, upon a prior foreign patent, would be to trifle with the obligations of the Government and the duties of the Office."

It appears that shortly after the Bland decision the practice of declaring an interference between a pending application claiming and a patent disclosing but not claiming an invention was discontinued. The practice of rejecting an application claiming upon a patent disclosing but not claiming an invention was continued and has been the uniform practice of the Patent Office to the present time. Instead of declaring an interference and determining the question of priority *inter-parties*, present Patent Office Rule 75 permits the applicant to overcome such a patent by making "oath to facts showing a completion of the invention in this country before the filing of the application on which the domestic patent issued." The history of Rule 75 is as follows:

Under a revision of the Rules of Practice put into effect Dec. 1, 1879, the following Rule appeared:

> "74. When an original or reissue application is rejected on reference to an expired or unexpired domestic patent, *which substantially shows or describes but does not claim* the rejected invention, or to a foreign patent, or to a printed publication, and the applicant shall make oath to facts showing a completion of the invention *before the filing of the application for the domestic patents*, or before the date of the foreign patent, or before the date at which the printed publication was made, and shall also make oath that he does not know and does not believe that the invention has been in public use, or on sale, in this country for more than two years prior to his application, and that he has never

> abandoned the invention, then the patent or publication cited will not bar the grant of a patent to the applicant, except upon interference as provided in Rule 94." (Italics ours.)

A revision of the Rules made Sept. 1, 1880, rendered the concluding exception of Rule 74, just quoted, obsolete, but otherwise the Rule remained unchanged.

By a revision made June 18, 1897, the rule was renumbered as 75, and was slightly amended in phrasing, but without any change in substance.

By a revision announced Nov. 19, 1897, and effective January 1, 1898, to conform to the Act approved March 3, 1897, Rule 75 was amended to read:

> "75. When an original or reissue application is rejected on reference to an expired or unexpired domestic patent which substantially shows or describes *but does not claim* the rejected invention, or on reference to a foreign patent or to a printed publication, and the applicant shall make oath to facts showing a completion of the invention in this country *before the filing of the application on which the domestic patent issued,* or before the date of the foreign patent, or before the date of the printed publication, and shall also make oath that he does not know and does not believe that the invention has been in public use or on sale in this country, or patented or described in a printed publication in this or any foreign country for more than two years prior to his application, and that he has never abandoned the invention, then the patent or publication cited will not bar the grant

> of a patent to the applicant, unless the date of such patent or printed publication is more than two years prior to the date on which application was filed in this country." (Italics ours.)

The above rule is at present in force and no change has been made in it during the past twenty-seven years.

It thus appears that for forty-five years last past a rule has been continuously in force in the Patent Office under which a cited earlier domestic patent, *which shows or describes but does not claim* the invention of a pending application, must be overcome by affidavit as to facts showing a completion of the invention in this country by the applicant named in the pending application, prior to *the filing date of the application for the cited domestic patent.* Failing such affidavit, a patent showing but not claiming the invention and having an earlier filing date has been sufficient ground upon which to refuse a patent to a later applicant.

Under the practice of the Patent Office, for at least fifty years last past, the application for the Whitford patent, here involved, should have been rejected upon the Clifford patent which was issued while the Whitford application was pending and which admittedly disclosed, without claiming, the invention claimed by Whitford. The allowance of the Whitford patent was an oversight, as it is admitted that Whitford cannot carry his date of invention back of the filing date of the application for the Clifford patent.

The doctrine announced by the Court below is diametrically opposed to the uniform interpretation of the law by the Patent Office through many administrations and this Court, following the rule announced in United States vs. Hill (supra p. 19) and United States vs. Pugh, 99 U. S. 265, 269, will undoubtedly regard the long established practice in the Patent Office with great respect. In Bate Refrigerating Co. vs. Sulzberger 157 U. S. 1, 26 to 30, this Court examined the decisions of the Commissioner of Patents in detail.

Patent Office Practice Under Rule 75.

The reasons assigned by the Patent Office for rejecting an application upon reference to a patent disclosing but not claiming, and based upon an earlier copending application, are set forth quite fully in Ex parte Grosselin (97 O. G. 2977), decided by Commissioner Allen, as follows:

> "The necessity for refusing a patent to an applicant is not limited to cases where a prior inventor makes claim before this Office to the invention, but exists whenever that prior invention and disclosure in this country are satisfactorily established by any means. Whenever this Office has satisfactory evidence that some other person is as against the applicant entitled to the patent, it is, under the general principles of the law which are well recognized, bound to reject the application. If the inventor, who as against others is under the law entitled to the patent, chooses, he may abandon the invention to the public by a full

disclosure without making claim to it, and when he does so no one else acquires the right to obtain a patent. (Miller vs. Brass Co., C. D. 1882, 49; 210 G. 201; 104 U. S. 350; Mahn vs. Harwood, C. D. 1885, 144; 30 O. G. 657; 112 U. S. 354; Independent Electric Co. vs. Jeffery, C. D. 1897, 287; O. G. 797.) The public assumes whatever rights to the invention he had, and it would be contrary to the law and a fraud upon the public to grant a patent to another. As was said by the Court of Appeals of the District of Columbia in the case of Millett and Reed vs. Duell, (post 410; 96 O. G. 1241), where the application was rejected because of previous invention by one Lane—'It is of no consequence that Lane does not include this device among the claims of his own invention. His failure to do so simply implies that he abandoned it to the public, or that he regarded it as already well known to the art. It does not help the appellants in any manner that he does not claim it'."

* * * * * * *

"The statutes make no provision directly by which an applicant may establish his right to a patent over a reference showing and describing, but not claiming, the invention by proving that he is in fact the first and original inventor. There can be no contest where the reference is not a United States application or patent claiming the invention. By analogy to the statute relating to interferences, however, the applicant should be permitted to show in some way that he is the prior inventor and entitled to a patent in spite of the reference, and since there can be no contest the Office by Rule 75 permits him to make an ex parte showing of his rights. In that ex parte showing, however, it requires the same kind

of facts to be set forth which, if true, would establish prima facie his right to a patent even if the reference claimed the invention. The whole proceeding is by analogy to the interference practice, and therefore, it follows that practice as closely as possible. This is necessary for the protection of the public."

* * * * * * *

"To hold that Congress intended to establish two rules of evidence for determining the effective date of invention—one to be applied where the rights of applicants were to be determined inter partes and another where they were to be determined ex parte—would lead to endless confusion. A question which is ex parte one day may be raised inter partes the next."

Prior Knowledge or Use by a Single Person is Sufficient to Defeat a Patent. The Number Is Immaterial.

Coffin vs. Ogden, 18 Wall. 120, 124.
Bedford vs. Hunt, 1 Mason 302.
Reed vs. Cutter et al, 1 Story 590, 596, 598.
In the latter case Story, J., said:

"If the invention is perfected and put into actual use by the first and original inventor, it is of no consequence, whether the invention is extensively known or used, or whether the knowledge or use thereof is limited to a few persons, or even to the first inventor himself. It is sufficient that he is the first inventor, to entitle him to a patent; and no subsequent inventor has a right to deprive him of the right to use his own prior invention. The language of the Patent Act of 1836, ch. 357, Sec.

> 6, 15, and of the Patent Act of 1837, ch. 45, Sec. 9, fully establishes this construction; and, indeed, this has been the habitual, if not invariable, interpretation of all our Patent Acts from the origin of the Government."

In Pennock et al vs. Dialogue, 2 Peters 1; 1 Robb's Patent Cases 542, 566, it is said, referring to the Act of 1793:

> "The sixth section in the clause under consideration, may well be deemed merely affirmative of what would be the result from the general principles of law applicable to other parts of the statute. It gives the right to the *first* and true inventor and to him only; if known or used before his supposed discovery he is not the *first*, although he may be a *true* inventor; and that is the case to which the clause looks."

In Sewall vs. Jones, 91 U. S. 171, 179, 180, it is said:

> "It is an elementary proposition in patent law, that, to entitle a plaintiff to recover for the violation of a patent, he must be the original inventor, not only in relation to the United States, but to other parts of the world. Even if the plaintiff did not know that the discovery had been made before, still he cannot recover if it has been in use or described in public prints, and if he be not in truth the original inventor. *Dawson* vs. *Follen*, 2 Wash. C. C. 311; *Bedford* vs. *Hunt*, 1 Mas. 302."

Abandoned Applications as Compared With Patented Applications.

The Court below said:

> "There seems no material difference between the attitude of one who files application

> for a patent and never presses it, and one who does the same thing and never uses a portion of his disclosure. It was held in the Corn-Planter Patent, 23 Wall., 181, that a mere application, subsequently abandoned or withdrawn, was no bar to a subsequent patent therefor to another" (R., p. 105).

We can see no analogy between an abandoned application, which is never given to the public, and an application duly prosecuted and published to all the world. The one is like a corpse, buried; the other has perpetual life.

On this question the Circuit Court of Appeals, First Circuit, speaking by Judge Colt, in Automatic Weighing Machine Co. vs. Pneumatic Scale Corporation 166, F. R. 288, 297 said:

> "The cases which hold that a rejected application is not sufficient to establish priority of invention under the statutes have no bearing on the question of the legal effect of a complete and allowable application which will result or has resulted in the granting of a patent. These cases simply enforce the rule that an invention must be perfected and adapted to use in order to prove prior invention or prior use. The Corn-Planter Patent, 23 Wall. 181, 23 L. Ed. 161; Lyman Ventilating & Refrigerator Company vs. Lalor, 1 Ban. & Ard. 403, Fed. Cas. No. 8,632; Northwestern Fire Extinguisher Company vs. Philadelphia Fire Extinguisher Company, 1 Ban. & Ard. 177, Fed. Cas. No. 10,337."

Secrecy in the Patent Office.

The Court below said:

> "The question may be thus put,—is mere disclosure (confidentially made to the Commissioner of Patents) and no more per se, sufficient evidence of invention?"

The Court does not seem to attach much importance to the words "confidentially made to the Commissioner of Patents," but we call attention to the fact that there is nothing in the Clifford record (R., p. 57) to indicate that he desired his application to be treated as confidential.

Rule 15 of the Patent Office Rules of Practice provides that

> "Pending applications are preserved in secrecy."

This is merely a rule of convenience for the conduct of the Office and is not prescribed by statute. On the contrary, R. S. 892 provides that

> "Written or printed copies of any records, papers or drawings belonging to the Patent Office and of Letters Patent authenticated by the seal and certified by the Commissioner or Acting Commissioner thereof, shall be evidence in all cases wherein the originals could be evidence; and any person making application therefor, and paying the fee required by law, shall have certified copies thereof,"

In the Act of 1836, Section 12, providing for the filing of caveats, it is said:

> "And such caveat shall be filed in the confidential archives of the Office, and preserved in

> secrecy. And if the application shall be made by any other person within one year from the time of filing such caveat, for a patent of any invention with which it may in any respect interfere, it shall be the duty of the Commissioner to deposit the description, specifications, drawings and model, in the confidential archives of the Patent Office and to give notice by mail, to the person filing the caveat."

This, we believe, is the only reference in the Patent Statutes to "confidential archives of the Patent Office." This special provision that an application which would interfere with a caveat was to be deposited in the confidential archives would indicate that the law contemplated that other applications were not so deposited, and not required to be kept secret, following the maxim: Expressio unious est exclusio alterius.

The law relating to caveats was repealed by Act of January 25, 1910, and there is now no statute in force requiring that any application be kept secret. Pending applications are made public when they interfere with other applications or with patents and when they are appealed to the Court of Appeals, D. C. It is believed that the rule of secrecy should not be given effect in the Courts to defeat the rights of the public and of the first inventor or discloser in matter disclosed but not claimed in an application duly patented.

Confusion in the Cases.

In the cases we have referred to, and many others having a bearing on the fourth defense under R. S.

4920, there is much confusion. This has resulted in a measure from improper pleading. In many cases and in the present case, the Courts have confused the issue with discussion as to whether the evidence of prior knowledge or use offered was evidence of prior "invention" by the earlier discloser. The right of the public to what was disclosed and not claimed by the earlier applicant for patent has usually not been considered. The uniform and consistent practice of the Patent Office has never been mentioned. The presumption that what an applicant for a patent discloses and does not claim was old when the application was filed, has been overlooked.

All of these have a bearing on the question whether the patentee of a patent in suit was the "first inventor." The established law that a complete filed application is evidence of completed invention of the disclosure at the date of filing, that is, reduction to practice of the disclosure, regardless of claims, (Chapman vs. Wintroath, 252 U. S. 126, 135, 137) has not been seriously applied in considering the defense that a later inventor was not a "first inventor."

The Patent Office, in a case like the present, rejects an application on a patent showing but not claiming the invention claimed by a later applicant if the application upon which the patent issued is of earlier date. In such case the Patent Office has within its records documentary evidence of the earlier disclosure and it would seem to be illogical and inconsistent with the statutes for the Patent Office to ignore such earlier disclosure. Yet if the doctrine announced by the Court below is sound, a later in-

ventor may come in and claim anything which prior inventors have disclosed without claiming if he makes his application before, even one day before, a patent issues carrying the earlier disclosure. The earlier discloser would thus be ousted of his right to use what he either invented or knew to be old at the time he filed his application and the public would be ousted of its right to use what was either old when the earlier application was filed or dedicated by the earlier inventor. The doctrine of reduction to practice by filing an application, which means that the filing of a complete application is equivalent to the building of a complete operative embodiment of the invention, a completion of the inventive act, is wholly inconsistent with the theory that one who conceives the invention later and files his application later is to be regarded the "first inventor" if only he claims what the earlier applicant did not claim.

The Patent Statutes.

In the last analysis the statutes of course govern and it seems to us that the opinion of the Court below is inconsistent with them, taken as a whole. Section 4886 provides that any person may obtain a patent who has invented something "not known or used by others in this country before his invention or discovery thereof." Section 4892 requires that the applicant for a patent "shall make oath that he does verily believe himself to be the original and first inventor or discoverer" of the thing for which he solicits a patent. In order that two patents may not issue for the same invention Section 3904 pro-

vides for interference proceedings to be instituted by the Commissioner "to determine the question of priority of invention," and in such cases the patent is always issued to the first inventor. Section 4917 provides that "when a patentee has claimed more than that of which he was the original or first inventor or discoverer he may make disclaimer of such parts of the thing patented as he shall not choose to hold." Section 4920 provides that in any action for infringement the defendant may plead and prove on trial that the patentee "was not the original and first inventor or discoverer of any material and substantial part of the thing patented." Section 4923 provides that when a patentee at the time of making his application "believed himself to be the original and first inventor and discoverer of the thing patented "his patent shall not be held void on account of the invention or discovery having been known or used in a foreign country prior to his invention or discovery if it had not been patented or described in a printed publication." This is the only exception in the statutes to the rule that the first inventor only is entitled to a patent and that a patent is invalid if issued to one who is not the first inventor.

Throughout the patent statutes in force and all previous statutes relating to patents, it is provided that the first inventor only is entitled to a reward. The only exceptions are cases where the invention, previously known, has become a "lost art," or where the previous knowledge was in a foreign country and unpublished, or where the first inventor unduly kept his invention secret and took no steps to give

it to the public. Where the first inventor without reserve or delay gives his invention to the public, it is believed no later inventor is entitled to a monopoly under the statutes. The language of the statutes is explicit on this subject and there seems to be "no room for the office of construction." Lewis vs. United States 92 U. S. 618; Doggett vs. Florida R. Co. 99 U. S. 72; Bate Refrigerating Co. vs. Sulzberger 157 U. S. 1, 36, 37.

The Adoption of the Theory of the Court Below That a Claim Is Necessary to Evidence Completion of an Invention Would Increase Litigation and Create Confusion in the Patent Office and in the Courts.

Claims to the same invention by different inventors are naturally framed in different language and of different scope and under well established law a claim may be presented at any time while an application is pending, or, for the first time, after a patent issues, in a reissue application or a divisional application. If a claim is to be considered as a criterion of completed invention, the established doctrine of constructive reduction to practice of an invention by filing a complete allowable application would be a nullity, because, until the expiration of the time within which additional claims might be made had expired, the inventive act could not be deemed complete. An applicant might claim part of his invention in his original application and continue from time to time to claim additional parts, or to make broader or more specific claims for the

thing originally claimed, and we would have piecemeal completion of the invention notwithstanding it was fully described and illustrated at the time of filing the application. This would lead to endless confusion in the interference practice of the Patent Office and result in contests as to who was the first to claim this and that feature and as to the scope and meaning of claims, regardless of the disclosures in the specifications and drawings and the dates of filing the same.

In the Courts the same difficulties would be encountered in interference cases under Section 4918 R. S. and in cases involving the third and fourth defenses under Section 4920 R. S. Many difficult situations would arise and litigation would be complicated thereby. The present simple rule that an application duly filed in the Patent Office completely disclosing an invention is deemed constructive reduction to practice of the invention and a completion thereof as of the date of filing, to which date all allowable claims based on such disclosure, whenever made, relate back, is logical and simple and so is the practice thereunder established in the Patent Office and in the Courts. To depart from this rule in the direction indicated by the Court below would apparently be a calamity.

The Distinction Drawn by the Court Below Between An Application Claiming and One Describing Without Claiming Is Arbitrary, Artificial, And Not Founded in Substance.

The Court below said:

> "If Clifford had not only described but claimed the matter now sought to be used by

> defendant, the Sundh case, supra is clear in holding that in the absence of other evidence, and because an application is a constructive reduction to practice, Clifford would have been the original and first inventor or discoverer because he filed the first application; and the fourth defense would succeed" (R., p. 106).

In Mahn vs. Harwood, 112 U. S. 354, 361 this Court said:

> "The presumption is, and such is generally the fact, that what is not claimed was not invented by the patentee, but was known and used before his invention."

The proof of the prior disclosure of Clifford, the file-wrapper, is the same for what he omitted to claim as for what he claimed because, as Judge Hough well says in Westinghouse E. & Mfg. Co. vs. Metropolitan E. Mfg. Co. 290 F. R. 661, 664:

> "A claim is a definition of that which has been described in the specification. A disclosure tells how to do that of which the claim attempts definition. * * * A claim is not a disclosure; but every claim must be justified by the disclosure."

And so, we say, that the distinction drawn by the Court below between disclosure with claim and disclosure without claim lacks substance, it is purely artificial. If Whitford was not the first inventor of the subject matter here in controversy can it make any difference whether the anticipating matter found in the earlier application of Clifford was invented by

Clifford or known by him to be old at the time he filed his application? This seems to be the question for the Court to decide.

The case of Roberts vs. Ryer 91 U. S. 150 is almost on "all-fours" with the present case. The patent sued on was granted to Sanford Nov. 13, 1855. This Court said:

> "Sanford, the patentee does not carry his invention back of the Summer of 1855, when, it perhaps sufficiently appears, his application was filed" (p. 155).

The defense was that Sanford was not the "original and first inventor," and a patent to Lyman, applied for Sept. 21, 1854, was set up as evidence that Sanford was not the first inventor. Lyman's patent issued March 25, 1856, four months *after* the Sanford patent issued. This Court said:

> "Clearly Lyman was the oldest inventor, and his patent was consequently the best, although that of Sanford antedated his" (p. 158).
>
> "We think the evidence establishes beyond all question, that Lyman, and not Sanford, was the original and first inventor of all there is to this improvement" (p. 159).

Two circumstances only might possibly be considered as differentiating Roberts vs. Ryer from the present case. The earlier inventor claimed his invention rather broadly. Sanford claimed a specific improvement which the Court held to be unpatentable over Lyman unless he could carry his date of invention back of Lyman. The comparison drawn

however was between the subject matter which was claimed by Sanford and the subject matter disclosed by Lyman.

The other circumstance is that the Court referred to the fact that Lyman had built some refrigerators embodying the principle of his invention (p. 158). No mention is made of the dates when these were built, the only dates considered being the application and patent dates of the parties. We think clearly the case was decided on the fact of the earlier application and disclosure of Lyman, regardless of any devices that were built and regardless of the fact that Lyman claimed his invention. There is nothing in the case contrary to this proposition.

In the instant case Whitford simply escaped the vigilance of the Patent Office, which is not strange considering the volume of business passing through that office; otherwise his application would have been rejected on the Clifford patent. On the record here he would have been unable to overcome Clifford's filing date and his case would have become abandoned, as hundreds of others have in like circumstances. Whitford's patent was inadvertently issued. The Clifford file-wrapper discloses that Whitford was not the first inventor and sustains the fourth defense under R. S. 4920.

Respectfully submitted,

JAMES A. WATSON,
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Washington, D. C.
November 2, 1925.

APPENDIX.

Cases Under the Earlier Patent Acts Holding First Inventor Only Entitled to Patent.

Section 1 of the law of the Patent Act of 1790 provided for the issuing of a patent for any invention or discovery or improvement therein "not before known or used" and Section 2 provided that the grantee of each patent should file a specification in writing so particular as to "distinguish the invention or discovery from other things before known or used."

The Act of 1793, Section 1, provided for issuing a patent to any inventor of a new and useful art, etc., "not known or used before the application" for the patent and in Section 6 it was provided that the defendant in an action on the case upon notice to the plaintiff might offer proof "that the thing, thus secured by patent, was not originally discovered by the patentee, but had been in use."

In the Act of 1836, Section 6, it is provided that any person or persons having discovered or invented any new and useful art, etc., "not known or used by others before his or their discovery or invention thereof" etc., shall be entitled to a patent. Section 7 of this Act provided for examination of applications by the Commissioner and provided for rejection of an application "whenever, on such examination, it shall appear to the Commissioner that the applicant was not the original and first inventor or discoverer thereof." Section 15, the defense section, provided that the defendant in any action for in-

fringement might show, among other things, "that the patentee was not the first inventor or discoverer of the thing patented, or of a substantial and material part thereof claimed as new."

In the Patent Law now in force R. S. 4886 provides for the issuance of a patent to any person who has discovered or invented any new and useful art, etc., "not known or used by others in this country, before his invention or discovery thereof." R. S. 4892 requires that the applicant for patent shall make oath that he verily believes himself "to be the original and first inventor or discoverer of the art," etc., for which he solicits a patent.

From the beginning of patent litigation in this country the courts have almost universally held that prior knowledge of an invention evidenced by written description or drawings sufficient to enable a skillful workman to practice the invention would defeat a patent granted to one who conceived the invention later. We quote here from Digest of American Cases Relating to Patents for Inventions from 1789 to 1862, by Stephen D. Law, published in 1862, memoranda of a few of the cases decided under the Act of 1836 and the earlier Acts, referring to the pages and sections.

> Page 243, Sec. 23: "The defense, provided by Section 15 of the Act of 1836, 'that the patentee was not the original and first inventor or discoverer of the thing patented,' is complete without showing that the first inventor had put his invention in practice. Hildreth vs. Heath, MS. (App. Cas.)—Cranch, Ch. J.; D. C., 1841."

Page 444, Sec. 4: "The original inventor of a machine is exclusively entitled to a patent for it. Odiorne vs. Winkley, 2 Gall., 53.—Story, J.; Mass., 1814."

Page 444, Sec. 5: "The first inventor is entitled exclusively to a patent-right, though a subsequent person may have also been an original inventor. The law gives the right, as among inventors, to him who is first in point of time. Lowell vs. Lewis, 1 Mas., 190.—Story, J.; Mass., 1817."

Pages 444 and 445, Sec. 6: "The first inventor who has put the invention in practice, and he only, is entitled to a patent. Every subsequent patentee, although an original inventor, may be defeated of his patent-right upon proof of such prior invention being put in use. The law adopts the maxim, Qui prior est in tempore, potior est in jure. Bedford vs. Hunt, 1 Mas., 304. Story, J.; Mass., 1817."

Page 445, Sec. 10: "But if a first inventor reduced his theory to practice, and put his machine or other invention into use, the greater or less use of it, or the more or less widely the knowledge of it might circulate, does not constitute a criterion by which to decide upon the validity of any subsequent patent for the same invention. Ibid., 305."

Page 445, Sec. 15: "Under our patent laws, no person who is not at once the first as well as the original inventor, by whom the invention has been perfected and put into actual use, is entitled to a patent. Reed vs. Cutter, 1 Story, 596, 598.—Story, J.; Mass., 1841."

Pages 445 and 446, Sec. 16: "A subsequent inventor, though an original inventor, is not entitled to any patent, and no subsequent inventor has a right to deprive an original in-

ventor of the right to use his own prior invention. Ibid., 596, 597."

Page 446, Sec. 23: "A patent issued to second inventor, before the application for a patent by the first inventor, which will bar the issuing of a subsequent patent to the first inventor, must be, comparing Section 7 with Sections 6, 8, and 15 of the act of 1836, a patent issued prior to his invention, and not merely prior to his application. Hildreath vs. Heath, MS. (App. Cas.)—Cranch, Ch. J.; D. C., 1841."

Page 450, Sec. 57: "He who first makes known sufficiently an invention, by describing it in words or drawings, will be considered the first inventor, and vested with an inchoate right to its exclusive use, which he may embody, perfect, and make absolute by proceeding to mature it in the manner which the law requires. Hill vs. Dunklee, MS. (App. Cas.) —Morsell, J.; D. C., 1857."

Page 450, Sec. 59: "The first inventor is not he who made or perfected the first machine or instrument, but he who was the first to conceive the idea, and who so described it by words or drawings sufficient to enable a skillful workman to bring it into useful practical operation. Davidson vs. Lewis.—Morsell, J.; D. C., 1858."

Page 596, Sec. 9: "Under Section 6 of the Act of 1793, if the thing had been in use or known anterior to the patentee's supposed discovery, his patent is void. Though the patentee had no knowledge of such previous use, still his patent is void, as the law supposes he may have known it. Evans vs. Eaton, 3 Wheat., 514.—Marshall, Ch. J.; Sup. Ct., 1818."